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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012
2292	7590	03/18/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			CHANG, VICTOR S	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	
			1771	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,930

Applicant(s)

HIRAMATSU ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,8 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,8 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' declaration, amendments and remarks filed on 1/21/2005. Applicants' amendments to claim 4, and new claims 24-28 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, upon reconsideration, Applicants' argument "The sheet of JP '656 ... has a foam layer itself exhibiting adhesiveness on its surface, and not a layer having a pressure sensitive adhesive coated on the surface of a foam layer" (Remarks, page 11, first full paragraph) is persuasive, as such the prior rejection of claims 2, 8, 22 and 23 over JP 11-254656 is withdrawn, and Applicants' remarks directed to claims 2,8, 22 and 23 are moot. The Examiner apologizes for misreading the computer translation.

Claim Rejections - 35 USC § 112

4. Claims 2, 8 and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that independent claim 2 has been amended to recite, *inter alia*, wherein the pressure-sensitive adhesive is solid", and deleted unsupported phrase "excluding a foaming pressure sensitive adhesive layer" from claim 2. The Examiner notes that while the deletion overcomes the prior 112, 1st paragraph rejection (see Office action dated 7/28/2004, page 3), Applicants fail to provide any express or inherent support for above-mentioned amendment, and it appears to be new matter. Further, with respect to Applicants' statement "claim 2 as amended includes the term "solid" in describing the adhesive layer, as suggested by the Examiner" (Remarks, page 8, third paragraph), the Examiner would like to clarify that the suggestion provided in the prior Office action is merely to indicate that positive recitation would have overcome the unsupported negative recitation (i.e., excluding). However, Applicants still must provide a clear express or inherent support for such an amendment. In particular, such an amendment would have narrowed the scope of the instant invention, and precluded the teaching of JP 11-254256, as such in the absence of a clear support, it amounts to a subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants must either provide support for this amendment, or cancel the new matter in the next reply.

5. Claims 3 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-254656 (computer translation), generally as set forth in section 6 of Office action dated 7/28/2004, together with the following additional reasoning.

First, the Examiner repeats the teachings of relied upon JP 11-254656 as follows: JP '656 is directed to an adhesive sheet for screen printing plate cleaning, which consists of a base (substrate) layer 2 and a self-adhesive foam layer 3 (Drawing). The cleaning sheet is pasted to the screen printing plate to adhere and absorb the ink, so as to remove the ink from the printing plate (Abstract). Suitable adhesives include natural rubber, styrene butadiene rubber, polyisobutylene, styrene-isoprene-styrene block copolymer, acrylic resin (such as a copolymer of acrylic acid and C₂-C₁₀ alkyl ester), styrene-acrylic ester copolymer, etc. (paragraph 0008). Further, JP '656 expressly teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm (JIS-Z-0237).

For claim 3, the Examiner repeats (see Office action dated 7/28/2004, page 4) that although JP '656 is silent about the solvent absorption rate from the ink, JP '656 does expressly teach that the adhesive foam layer cleans the printing plate by adhering and adsorbing the ink, as set forth above. As such, since JP '656 teaches substantially the same subject matter (an adhesive sheet for screen printing plate cleaning; the same suitable adhesive copolymers, e.g., styrene-butadiene-styrene copolymer; and the same adhering and adsorbing cleaning method) as the instant invention, it is the Examiner's position that, in the absence of unexpected results, a suitable solvent absorption rate is an obvious optimization to one of ordinary skill in the art, motivated by the desire to cleanly remove the ink from the printing plate. Finally, it should be noted that the fact that JP '656 teaches additional structural element (i.e., foamed structure) not claimed is irrelevant.

For new claims 24 and 25, the Examiner notes that JP '656 expressly teaches that various additives such as plasticizer, antioxidant, etc., may be contained in the foamed adhesive layer (paragraph 0009).

For new claim 26, JP '656 expressly teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm. It should be noted that while the unit in claim 26 (cN/25-mm) is different from the unit of JP '656 (gf/25-mm), both results are obtained by the same JIS-Z-0237 testing method. As such, in the absence of evidence to the contrary, they are apparently equivalent unit.

For new claim 27, JP 11-254656 expressly teaches that suitable adhesives include acrylic resin, such as a copolymer of acrylic acid and C₂-C₁₀ alkyl ester and styrene, etc. (paragraph 0008).

For new claim 28, the Examiner repeats (see Office action dated 7/28/2004, page 5) that JP '656 does teach that crosslinking agent may be contained in foamed adhesive layer 3 (paragraph 0009), and in the absence of unexpected results, it is the Examiner's position that since JP '656 teaches essentially the same subject matter (an adhesive sheet for screen printing plate cleaning), and the same suitable acrylic adhesive copolymers as the instant invention, a suitable amount of crosslinking agent is an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain an adhesive which retains its structural integrity after absorbing the solvent from the ink.

Response to Argument

6. With respect to the declaration, Applicants' argument "Declaration clearly shows the inferior results of the cited JP '656 reference. Both Examples A and B in the Declaration correspond to Example 2 of JP '656 ... As illustrated ... the adhesive sheet of JP '656 loses tackiness at the same time as absorbing the solvent ... in contrast to the present invention, wherein the instantly claimed pressure-sensitive adhesive sheet still has sufficient tackiness remaining even after absorbing ... solvent" (Remarks, page 13) has been carefully considered, but is not persuasive. First, the Examiner would like to point out that the Declaration fails to provide any direct comparative data between JP '656 and instant invention. Second, while the data show two Examples corresponding to Example 2 of JP '656, it should be noted that Example 2 does not limit the scope of JP '656. In particular, JP '656 also expressly teaches that the expansion ratio varies widely between 1.2 to 100 times (paragraph 0009), i.e., it ranges from substantially solid (1.2 times) to highly foamed (100 times), whereas the declaration fails to indicate what are the expansion ratio of the Examples, as such it fails to persuasively show that all the foamed adhesive sheet taught by JP '656 performs poorly. Third, even if the expansion ratio is provided, in view of the clear trend provided by the Examples, i.e., the greater the expansion ratio, the poorer the solvent absorption, and the poorer the tackiness before and after absorption, it would have been an obvious selection/optimization to one of ordinary skill in the art of an adhesive for printing plate cleaning application to optimize the performance of the adhesive sheet by selecting a substantially un-foamed adhesive layer. In other words, other than providing a contrast between expansion

ratio, the results are expected by an obvious selection/optimization, and the declaration fails to provide any unexpected results.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC
Victor S Chang
Examiner
Art Unit 1771

3/9/2005



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700